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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,495

07/15/2004

Lawrence Weekhar Lee

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EXAMINER

ROBINSON, KITO R

ART UNIT

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4143

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,495	<b>Applicant(s)</b> LEE, LAWRENCE WEEKHAR	
	<b>Examiner</b> KITO R. ROBINSON	<b>Art Unit</b> 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the application filed on 15 July 2004.
2. Claims 1-15 are currently pending and have been examined.

### Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 9, 13 & 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language *non-visual format* has no special meaning and for the purposes of this examination the Examiner will interpret the language to mean **audio format**.

### Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Ensel et al. US 6,493,685 B1.

**As per claim 7,**

Ensel discloses:

- *storing a list of the entities where the user maintains one or more accounts and a list of such accounts* (see at least column 10 line 40-41: take note database stores preferred payment mechanism)
- *storing the user information required for access to the accounts* (see at least column 10 line 25-30: take note database stores a password);
- *sending instruction via a communication network to the entity for access to electronic documents* (see at least column 10 line 25-30: take note a preferred presentment vehicle);
- *downloading the electronic documents that have not been previously downloaded in the visual format provided by the issuing entities* (see at least column 10 line 30-33: take note customer presentment preference)
- *storing the downloaded electronic documents in the visual format provided by the issuing entities to the user specified electronic storage device* (see at least Column 11 line 4-5: take note to each biller can custom format the entire look and feel of its bill);
- *storing a list of the downloaded electronic documents associated with each of the user's accounts* (see at least Column 4 line 1-8);
- *retrieving electronic documents matching the criteria specified by the user* (see at least Column 10 line 57-58: take note that current E-bill or historical E-bill data = criteria specified by user);
- *displaying the retrieved electronic documents in the visual format provided by the issuing entities* (See at least Column 11 line 4-5: take note to each biller can custom format the entire look and feel of its bill).

**Claim Rejections - 35 USC § 103**

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
15. Claims 1, & 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner et al. US 6,275,229 B1, hereafter Weiner, and further in view of Riley US 2002/0077940 A1, hereafter Riley.

**As per claim 1**

Weiner teaches three display areas which are distinct from each other (see at least Column 4 line 33) and *displaying general information* (see at least Column 6 line 3-4) but does not teach *listing of one or more accounts, and displaying a list of documents, or displaying a webpage*. However, Riley teaches *listing of one or more accounts* (see at least para. 0072: take note all transactions posted to that account will be listed in the e-statement), *or displaying a webpage* (see at least Column 4 line 13-14: take note the workstation can be connected to a network= Internet website to download information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the three display screens & general information of Weiner with *listing of one or*

*more accounts and displaying a list of documents or displaying a webpage* of Riley because a user can identify information that is most relevant to their criteria (Weiner Column 2 line 44-45).

**As per claim 3 & 5**

Claims 3 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riley/Weiner as applied to above. Furthermore, Weiner discloses *display areas are individually resizable by the user* (see at least Column 4 line 40-43) & *additional display areas are used to request and receive information and instructions from user* (see at least Column 4 line 45-47: take note to additional graphics and text information describing search parameters and search results). A person of ordinary skill in the art would know *receiving information and instruction from the user* is the same as inputting search criteria and receiving results.

**As per claims 4 & 6**

Claims 4 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riley/Weiner as applied to above. Furthermore, Weiner discloses *displaying additional information on the user selected entity, account, or document* (see at least Column 4 line 44-45: take note to graphic window shows a graphic representation of the results) & *additional display areas used to display information or hyperlinks* (see at least Column 5 line 63-65: take note to as the cursor moves over the display the information in the status window changes respectfully). A person having ordinary skill in the art would know that hyperlinks open additional files or windows for viewing selected material which is the function performed by Weiner.

16. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner/Riley as applied to above, and further in view of Daniels et al. US 2003/0074672 A1, hereafter Daniels.

**As per claim 2**

The combination Cramer/Ensel discloses multiple display screens that perform *listing of one or more accounts, displaying general information and displaying a list of documents, and displaying a webpage* but does not disclose *third display area is used for browsing the internet generally*. However, Daniels teaches *third display area is used for browsing the Internet*

*generally* (See at least Para. 00142 & Fig 36: take note to a webpage, including mapped hyperlink content, may be shown at a third portion).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine multiple display screens that perform *listing of one or more accounts, displaying general information and displaying a list of documents, and displaying a webpage* Weiner/Riley with the *third display area is used for browsing the Internet generally* of Daniels because there is also a need for a system that enables the simultaneous display of computer-generated images, Internet content and full motion video from two or more signal sources (See at least Daniels para. 0009).

17. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel as applied to in the claim above and further in view of Riley.

**As per claim 8**

Ensel discloses storing, receiving, retrieving and displaying electronic documents but does not disclose *automatically sending instructions to user specified entities and accounts to check for electronic documents that have not been downloaded previously to the user specified electronic storage device; and automatic downloading of these documents*. However Riley does. See at least Para. 0071: take note posted transactions will be generated into the e-statement automatically.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine storing, receiving, retrieving and displaying electronic documents of Ensel with *automatically sending instructions to user specified entities and accounts to check for electronic documents that have not been downloaded previously to the user specified electronic storage device; and automatic downloading of these documents* of Riley because it allows the user to select the frequency of automatic e-statements for each account faster and more efficiently (Riley para 0075).

12. Claims 7 & 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel as applied to in the claim above and further in view of Kolling et al. 5,963,925, hereafter Kolling.

**As per claims 7 and 9**

Ensel discloses storing, receiving, retrieving and displaying electronic documents but does not disclose *downloading and storing electronic documents in non- visual formats provided by the issuing entities; and retrieving and displaying electronic documents in non- visual formats provided by the issuing entities*, however Kolling does see at least the Abstract: take note to electronic statements having the same look as paper statements as well as including video, audio, graphics, and custom enclosures.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine storing, receiving, retrieving and displaying electronic documents of Ensel with *downloading and storing electronic documents in non- visual formats provided by the issuing entities; and retrieving and displaying electronic documents in non- visual formats provided by the issuing entities* of Kolling because it allows billers to have the capability to create statements with custom, personalized messages based on customer characteristics (Kolling Column 4 line 18-20).

**As per claim 10,**

Kolling discloses:

- *optical character recognition of the information contained within the stored documents* (see at least Column 10 line 18-20: take note to scan/capture software for converting scanned images to PDF with automatic OCR).

**As per claim 11,**

Kolling discloses:

- *scanning of paper documents into electronic formats for storage, retrieval, and display on electronic devices* (see at least Column 10 line 18-20: take note to scan/capture software for converting scanned images to PDF with automatic OCR).

**As per claim 12,**

Kolling discloses:



- *receiving search criteria from the user via a user interface* (See at least Column 19 line 46);
- *searching for specific information contained within the stored electronic documents based on the criteria provided by the user* ( See at least Column 19 line 47-48);
- *retrieving the electronic documents containing the specific information that matches the user's criteria* ( See at least Column 19 line 52);
- *displaying the electronic documents containing the specific information that matches the user's criteria* (see at least Column 19 line 55).

**As per claim 13,**

Ensel discloses storing, receiving, retrieving and displaying electronic documents but does not disclose *accessing, downloading, importing, exporting, and storing electronic documents in non-visual formats; and organizing, archiving, and retrieving electronic documents in non-visual formats*, however Kolling does see at least the Abstract: take note to electronic statements having the same look as paper statements as well as including video, audio, graphics, and custom enclosures.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine storing, receiving, retrieving and displaying electronic documents of Ensel with *accessing, downloading, importing, exporting, and storing electronic documents in non-visual formats; and organizing, archiving, and retrieving electronic documents in non-visual formats* of Kolling because it allows billers to have the capability to create statements with custom, personalized messages based on customer characteristics (Kolling Column 4 line 18-20).

**As per claim 14,**

Ensel discloses storing, receiving, retrieving and displaying electronic documents but does not disclose *associating the electronic documents in visual format with their corresponding non-visual format electronic documents*, however Kolling does see at least the Abstract: take note

to electronic statements having the same look as paper statements as well as including video, audio, graphics, and custom enclosures.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine storing, receiving, retrieving and displaying electronic documents of Ensel *associating the electronic documents in visual format with their corresponding non-visual format electronic documents formats* of Kolling because it allows billers to have the capability to create statements with custom, personalized messages based on customer characteristics (Kolling Column 4 line 18-20).

**As per claim 15,**

Ensel discloses:

- *collecting electronic documents that require transaction processing* (see at least Column 4 line 39-40: Take note to presents bills and also processes the payment);
- *receiving instructions for processing transactions relating to the electronic documents, the specific amounts to process, the dates to process, and authorization information from the user* (see at least Column 10 line 27, 44, 54-56: take note to password=authorization, account balance & due date);
- *sending instructions to a transaction processing entity for transaction processing* (see at least column 10 line 21-23: take note the database receives sends and receives information);
- *receiving transaction processing confirmation information from the transaction processing entities* (see at least column 10 line 21-23: take note the database receives sends and receives information);
- *storing transaction processing records and confirmation information* (see at least Column 10 line 58: take note to the E-Bill data is retained for a certain period of time).

**Conclusion**

- 18.** The Prior are made of record not relied upon is considered pertinent to applicant's disclosure.
- Schutzer US 6,292,789- discloses an electronic bill presentment system which is easy to use, makes use of software that is easy to use, and which can serve many parties, so that billers and consumers are not faced with a system available for only a small portion of their bills(Column 2 line 4-9)
  - Bankston, Karen. "In Step with Members". *Credit Union Management*. Madison: Mar 2002. Vol. 25, Iss. 3; pg. 54, 3 pgs- discloses a service that allows members to store all their account balances and other financial data available on line from New England FCU and other institutions-on one secure e-statement. By logging on to [www.2nefcu.com](http://www.2nefcu.com), members can access PC banking services from their Web-- enabled cell phone or PDA."

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kito Robinson** whose telephone number is **571.270.3921**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Reagan** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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January 3, 2008  
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